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WASHINGTON, DC 20005

EXAMINER

PHAM, KHANH B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/848,437	Applicant(s) BLAIR ET AL.	
	Examiner Khanh B. Pham	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/2008 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-48, 63-92 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-48, 92 recite “a method” which does not meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. Since the instant claimed method does not appear to satisfy either requirement, the method is not a “process” within the meaning of 35 U.S.C 101.

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Claims 63-91 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 21-92** are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al. (US 5,721,910 A), in view of Hill et al. (US 5,787,424 A), hereinafter referred to as “**Unger**” and “**Hill**”.

As per claim 21, Unger teaches a method for enabling a user to organize and analyze information comprising:

- “searching a first group of document according to one or more search functions to output a second group of documents, wherein the second group of documents is a subset of the first group of documents” at Col. 3 lines 8-20
- “wherein the search functions comprises at least on of the following: morphological, lexical, syntactic, semantic, discourse, pragmatic, full text, Boolean, clustering function” at Col. 3 lines 8-20;
- “analyzing a third group of document according to one or more analytical functions to output a fourth group of documents, wherein the fourth group of documents is a subset of the third group of documents” at Col. 6 lines 25-55;

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- “wherein the analytical functions comprises at least one of mapping functions, citation functions, plot lineage functions and reporting functions” at Col. 6 lines 25-55

Unger does not explicitly teach “selectively iterating at least one of the searching step and analyzing step, wherein each iteration of the searching step or the analyzing step is performed using as input the second group of documents, the fourth group of documents, or the output of the previous iteration, wherein in said selectively iterating step includes: performing an additional iteration of the searching step using as input the second group of documents, to output a fifth group of documents, wherein the fifth group of documents is a subset of the second group of documents; and performing an additional iteration of the analyzing step using as input the fourth group of document to output a sixth group of documents, wherein the sixth group of documents is a subset of the fourth group of documents”

Hill teaches a method for recursive document retrieval including the steps of selectively iterating at least one of the searching step and analyzing step, wherein each iteration of the searching step or the analyzing step is performed using as input the second group of documents, the fourth group of documents, or the output of the previous iteration, wherein in said selectively iterating step includes: performing an additional iteration of the searching step using as input the second group of documents, to output a fifth group of documents, wherein the fifth group of documents is a subset of the second group of documents; and performing an additional iteration of the analyzing step using as input the fourth group of document to output a sixth group of documents, wherein the sixth group of documents is a subset of the fourth group of documents” at

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Col. 3 line 1 to Col. 4 line 25 and Figs. 1-4. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Hill's iteration method with Unger's method as suggested by Hill at Col. 4 lines 10-20, in order to improve the relevancy of the search results, because: "this process solves a problem with conventional document retrieval methods that if the repository of documents is large, then conventional retrieval systems with reasonably high recall suffer from low precision. These conventional system suffer from this problem because, to have high recall, these system retrieve large number of documents, many of which are irrelevant", as noted by Hill at Col. 4 lines 10-22.

As per claim 22, Unger and Hill teach the method of claim 21 discussed above. Unger also teaches: "making at least one of the second group or the fourth group a permanent group" at Col. 3 lines 45-50.

As per claim 23, Unger and Hill teach the method of claim 21 discussed above. Unger also teaches: "wherein the searching comprises: performing a cluster analysis of the first group of documents to create a hierarchical arrangement of groups containing documents from the first group, wherein the second group is one of the hierarchical arrangement of groups" at Col. 5 lines 35-63.

As per claim 24, Unger and Hill teach the method of claim 21 discussed above. Unger also teaches: "performing a relevancy visualization analysis of one of the first

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group and the third group to identify how documents contained therein are inter-related with respect to key terms”

As per claim 25, Unger and Hill teach the method of claim 24 discussed above.

Unger further teaches: “relevancy visualization analysis operates according to a rule book” at Col. 5 lines 15-35.

As per claim 26, Unger and Hill teach the method of claim 25 discussed above.

Unger further teaches : “wherein the rule book comprises patent specific rule” at Col. 5 lines 15-35.

As per claim 27, Unger and Hill teach the method of claim 21 discussed above.

Unger further teaches : “generating an object corresponding to a search process component or an analyze process component of a work flow represented by the searching, the analyzing, and selective iterating” at Col. 7 line 25 to Col. 8 line 50.

As per claim 28, Unger and Hill teach the method of claim 27 discussed above.

Unger further teaches: “wherein an object is generated using object definition” at Col. 8 lines 35-50.

As per claim 29, Unger and Hill teach the method of claim 28 discussed above.

Unger further teaches: “wherein the object definition comprise: a Boolean operation

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object definition, a corporate family operating object definition; an export object definition; a folder object definition; an import object definition; a list exploder operation object definition; a list object definition; a query object definition; or a patent family dedupe object definition” at Col. 8 lines 35-50.

As per claim 30, Unger and Hill teach the method of claim 27, Unger further teaches : “saving the at least one object” at Col. 7 lines 25-50.

As per claim 31, Unger and Hill teach the method of claim 27, Unger further teaches: “re-executing the work flow by traversing the at least one object” at Col. 8 lines 50-62.

As per claim 32, Unger and Hill teach the method of claim 27, Unger further teaches: “creating a new work flow by modifying the at least one object” at Col. 8 lines 50-62.

As per claim 33, Unger and Hill teach the method of claim 21, Unger further teaches: “annotating at least one of the first group, third group, or any portion of any document contained in the first group or the third group” at Col. 4 lines 50-57.

As per claim 34, Unger and Hill teach the method of claim 21 discussed above. Unger further teaches: “wherein the initial group of documents is from at least one of a database, an external source, or the Internet” at Col. 4 lines 1-2.

Claims 35-92 recite a method, system, computer program product, and a device for performing similar method as in claims 21-34. Claims 35-92 are therefore rejected by the same reasons discussed above.

Response to Arguments

5. Applicant's arguments with respect to claims 21-92 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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In the case of amending the Claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is **(571) 272-3574** for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/
Primary Examiner
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February 5, 2009